

### **III. REMARKS/ARGUMENTS**

#### **A. Status of the Claims**

Claims 1-3, 5-19, 27-29 and 31-41 are pending. Claims 4, 20-26, 30, and 42-46 have been previously cancelled. Claims 1, 7, 9, 14, 18 and 19 have been amended. No new matter is introduced by these amendments, and these amendments are fully supported by the specification. Applicants respectfully request reconsideration of the rejections of these claims for at least the following reasons.

#### **B. Claim Rejections Under 35 U.S.C. § 101**

Claims 1-3 and 5-19 stand rejected under 35 U.S.C. § 101 for allegedly being directed to non-statutory subject matter. Specifically, the Office Action asserts:

In order for a method to be considered a “process” under § 101, a claimed process must either: (1) be tied to a particular machine or apparatus, or (2) transform a particular article to a different state or thing. If neither of these requirements is met by the claim, the method is not a patent eligible process under § 101 and is non-statutory subject matter.

With respect to independent claim 1, the claim language recites the steps of collecting department information, storing the department information in a database, assessing a criticality, storing the assessment of the criticality in a database etc., however the claim language does not include the required tie or transformation. Moreover, the recitation of storing various types of information and data in the database is considered a nominal tie, since it is insignificant extra-solution activity that does not satisfy the requirement.

Office Action, pages 2-3 (citations omitted). Although Applicants do not necessarily agree with this rejection, in an effort to expedite the prosecution of this

application, Applicants have amended the claims appropriately. Therefore, Applicants respectfully request that this rejection be withdrawn.

**C. Claim Rejections Under 35 U.S.C. § 103(a)**

1. Claims 1-3, 5-14, 17-19, 27-29, 31-36 and 39-41

Claims 1-3, 5-14, 17-19, 27-29, 31-36 and 39-41 stand rejected under 35 U.S.C. § 103(a) as allegedly rendered obvious by U.S. Patent No. 5,185,697 to Jacobs *et al.* (“Jacobs”) in view of U.S. Patent Application Publication No. 2004/0103431 to Davenport *et al.* (“Davenport.”). Specifically, the Office Action alleges that Jacobs discloses all elements of these claims but does not “explicitly disclose collecting department information, describing at least one department within the enterprise and developing a recovery and plan for recovery from degradation of a functionality of the at least one department.” Office Action, pages 4-5. Nevertheless, the Office Action refers to Davenport, which allegedly discloses “collecting critical facility information, wherein the facility may be a school, workplace, or any other public or private facility ..., and development of an emergency plan for the facility.” *Id.* at page 5 (citations omitted). Thus, the Office Action contends:

It would have been obvious to one of ordinary skill in the art to include collecting department information, describing at least one department within the enterprise and developing a recovery plan for recovery from degradation of a functionality of the at least one department in the Jacobs *et al.* system, as seen in Davenport *et al.*, since the claimed invention is merely a combination of old elements, and in the combination each element would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable

*Id.* Applicants respectfully disagree, as the Office Action has failed to create a *prima facie* case of obviousness.

Under 35 U.S.C. § 103, the Patent Office bears the burden of establishing a prima facie case of obviousness. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). There are four separate factual inquiries to consider in making an obviousness determination: (1) the scope and content of the prior art; (2) the level of ordinary skill in the field of the invention; (3) the differences between the claimed invention and the prior art; and (4) the existence of any objective evidence, or “secondary considerations,” of non-obviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966); *see also KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007). An “expansive and flexible approach” should be applied when determining obviousness based on a combination of prior art references. *KSR*, 127 S. Ct. at 1739. However, a claimed invention combining multiple known elements is not rendered obvious simply because each element was known independently in the prior art. *Id.* at 1741. Rather, there must still be some “reason that would have prompted” a person of ordinary skill in the art to combine the elements in the specific way that he or she did. *Id.*; *In re Icon Health & Fitness, Inc.*, 496 F.3d 1374, 1380 (Fed. Cir. 2007). Also, modification of a prior art reference may be obvious only if there exists a reason that would have prompted a person of ordinary skill to make the change. *KSR*, 127 S. Ct. at 1740-41.

Claim 1, as amended, recites:

1. A method for providing ***business continuity*** in an enterprise comprising:
  - using at least one computer processor, collecting ***department information describing at least one department within the enterprise***;
  - storing the department information in an electronic database;
  - using the at least one computer processor, ***assessing a criticality of the at least one department***;
  - storing the assessment of the criticality of the at least one

department in the electronic database;

using the at least one computer processor, *developing a recovery plan for recovery from a degradation of a functionality of the at least one department, wherein the recovery plan aims to ensure the business continuity of the at least one department;*

storing the recovery plan in the electronic database;

using the at least one computer processor, assessing the recovery plan;

storing the assessment of the recovery plan in the electronic database;

testing the recovery plan and recording the results of the testing;

storing the recorded results of the testing in the electronic database; and

using the at least one computer processor, providing status data from the electronic database, wherein the status data comprises at least one of a status of:

the collection of the department data;

the assessment of the criticality;

the development of the recovery plan; and

the testing of the recovery plan.

Appl'n, Claim 1 (emphasis added). Clearly, claim 1 is directed to a method for providing *business continuity* in an enterprise, and includes "collecting department information describing at least one *department* within the enterprise" and "developing a *recovery plan* for recovery from a degradation of a functionality of the at least one department, wherein the *recovery plan aims to ensure the business continuity of the at least one department.*"

Even though the Office Action has withdrawn the prior rejection under 35 U.S.C. § 102(e), the Office Action continues to give Jacobs an unreasonable and overbroad reading. For example, the Office Action still considers Jacob's "crisis

management” to read on “providing business continuity.” *See* Office Action, page 3 (“As per claim 1, Jacobs et al disclose a method for providing business continuity in an enterprise (i.e., crisis management)” (citations omitted)). This is simply not accurate. Jacobs is directed to a ***crisis management system*** for dealing with ***hijackings, kidnapping, and earthquakes***. Jacob’s examples of hijackings, kidnappings, and earthquakes ***have nothing to do with maintaining business continuity*** -- instead, Jacobs is concerned ***with the way in which these crises are handled*** by the FBI, FAA, CIA, etc. using, for example, the topic files. *See, e.g.,* Jacobs, Col. 5, ll. 44-46. Thus, there is a ***fundamental flaw*** in Jacobs’ disclosure that the Office Action has repeatedly refused to consider or respond to.

The Office Action must agree, as it has not specifically alleged that Jacobs (or Davenport, for that matter) discloses “developing a recovery plan for recovery ***from a degradation of a functionality of the at least one department***, wherein the recovery plan aims to ***ensure the business continuity of the at least one department***” as claimed. Indeed, the rejection set forth on pages 3 through 5 of the Office Action is wholly silent regarding the presence of this element in the prior art. The reason is quite simple -- this element is ***not*** present in the prior art, and the Office Action cannot provide a citation to support its allegations.

The Office Action has, however, cited Davenport as allegedly disclosing “collecting ***critical facility information***, wherein the facility may be a school, workplace, or any other public or private facility ..., and development of an ***emergency plan for the facility***.” Office Action, page 5. “Collecting critical facility information ... and development of an emergency plan for the facility,” however, are not claim elements. Nor is an emergency plan for a facility the same as a recovery plan aimed at ensuring business continuity. Thus, Davenport is wholly irrelevant to the pending claims.

To the extent that the Office Action may be alleging that Davenport discloses “collecting department information, describing at least one department within the enterprise and developing a recovery plan for recovery from degradation of a functionality of the at least one department,” the cited paragraphs of Davenport, however, do not support such an allegation:

[0004] In view of the many incidents of, in particular, violence in public in recent years, security and preventive measures have been taken to dampen the risks of terrorist attacks, school and workplace violence, and other violent incidents in public and/or publicly accessed facilities (as well as in many private facilities). Such measures include establishing policies, increasing awareness at large and consulting specialists who bring insight and historical knowledge to *identify causes of*, as well as *preventive measures for*, such emergencies.

\* \* \*

[0008] Key information needs of *responders to an emergency at a facility* typically include the following: detailed descriptive information about the facility, such as relevant contacts and utilities; maps and floor plans of the facility and surrounding area; emergency plans for communicating facility actions to responders; and any other predeveloped plans for managing an incident. *Such information typically is scattered amongst various sources and storage locations.*

\* \* \*

[0010] However, there is a need to collect, coordinate and centralize information vitally needed by emergency personnel, and provide such information in a manner and form that is easy to access and use. Thus, emergency responders (from any responding agency or jurisdiction) can quickly review substantially all *critical facility information*, and thereby coordinate tactical actions between agencies and communicate status during a school emergency.

Davenport, ¶¶ 4, 8, 10 (emphasis added). As can be seen, these paragraphs have nothing to do with “developing a recovery plan for recovery from degradation of a

functionality of the at least one department” that “aims to ensure the business continuity of the at least one department.” Instead, the cited paragraphs describe a plan for “managing an incident,” such as providing critical facility information to responders during an emergency. They do not disclose a recovery plan, let alone a recovery plan for ensuring business continuity of at least one department.

Because neither Jacobs nor Davenport discloses the “department information describing at least one department within the enterprise,” as claimed, they cannot disclose many other elements that recite this feature. For example, they do not disclose “collecting department information describing at least one department within the enterprise,” “storing the department information in an electronic database,” “assessing a criticality of the at least one department,” “storing the assessment of the criticality of the at least one department in the electronic database.”

This fundamental flaw in Jacobs has also resulted in the Office Action alleging that many elements of the claims are disclosed by Jacobs, when they really are not. For example, the Office Action improperly considers Jacob’s “topic files” to be a “recovery plan.” As claimed, the recovery plan “aims to ensure the business continuity of the at least one department.” Jacobs’ topic files, however, do not do this. Instead, Jacobs describes them as follows:

Each crisis situation possesses a predetermined number of topic files which organize the crisis information based upon the nature of the information in relation to the selected crisis. ***These topic files include topics such as suspects, victims, demands, evidence, vehicles involved, leads, and so forth for a crisis arising from illegal and terrorist activity, and topics such as current supplies, incoming aid, injuries, shortages, and so forth for a crisis arising from a natural disaster.*** Some topic files are employed for all crisis situations, whereas other topic files are specific to the crisis situation.

Jacobs, Col. 5, ll. 27-41 (emphasis added). Based on this description, Jacobs' topic files cannot be considered to disclose the claimed "recovery plan."

Further, the Office Action alleges that Jacobs discloses "assessing the recovery plan" because it discloses that a "crisis team member analyzes information with respect to the crisis." Clearly, analyzing a crisis -- and an ongoing crisis at that (*see* Jacobs, Col. 6, lines 46-50) -- is not the same as *assessing* a recovery plan that aims to ensure the business continuity of a department. In addition, Jacobs discloses this analysis being performed by a human, while the claim now requires that it is performed using a computer processor.

Similarly, Jacobs does not disclose "testing the recovery plan," "storing the recorded results of the testing" and "providing status data from the electronic database." On the last point, Table 2 of Jacobs discloses a topic file that includes the "Status of the Crisis" -- clearly not the status of data, but of the crisis itself. Because of this, there is no support for the Office Action's assertion that the "Status of the Crisis" includes "the collection of the department data; the assessment of the criticality; the development of the recovery plan; and the testing of the recovery plan."

Thus, as set forth above, the Office Action has failed to establish a *prima facie* case of obviousness for the pending claims. Applicants respectfully request that the rejection of the pending claims be withdrawn.

2. Claims 15, 16, 37 and 38

Claims 15, 16, 37 and 38 stand rejected as allegedly rendered obvious by Jacobs, Davenport, and further in view of U.S. Patent Application Publication No. 2005/0114653 to Sudia. Specifically, with regard to claims 15 and 16, the Office Action admits that Jacobs does not disclose "generating a wallet card for the



employee using the employee information, wherein the wallet card is generated at a workstation of the employee, and the wallet card contains a hotline, a website, and at least one emergency location that the employee can use in an emergency,” Office Action, page 11, the Office Action asserts that “Sudia discloses a certification authority giving a user a wallet card containing contact information pertaining to a lost, stolen, destroyed or compromised machine.” Office Action, page 12. Thus, the Office Action contends that:

[i]t would have been obvious to one of ordinary skill in the art to include a wallet card in the Jacobs et al system, as seen in Sudia, since the claimed invention is merely a combination of old elements, and in the combination each element would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

*Id.* The Office Action rejects claims 37 and 38 based on the “same rationale.” *Id.* Applicants respectfully disagree.

Applicants submit that the proposed combination of Jacobs, Davenport, and Sudia is improper, as the Office Action has failed to identify some “reason that would have prompted a person of ordinary skill to make the change.” *KSR*, 127 S. Ct. at 1740-41. Simply alleging, without support, that “each element would have performed the same function as it did separately” does not meet this standard. Therefore, on this ground alone, Applicants respectfully request that this rejection be withdrawn.

In addition, claims 15, 16 and claims 37 and 38 are dependent on independent claims 1 and 27, respectively, and are allowable for at least the reasons set for the above. *See* MPEP 2143.03 (“If an independent claim is nonobvious under 35 U.S.C 103, then any claim depending therefrom is nonobvious.”) (quoting *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988)). Therefore,

Applicant respectfully requests that the rejections of claims 15, 16, 37 and 38 be withdrawn.

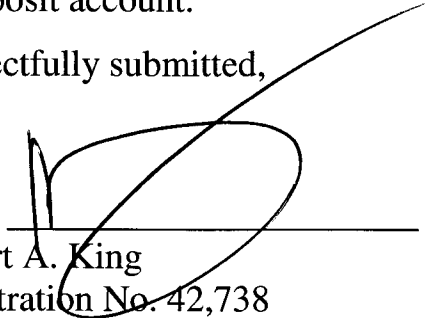
**IV. CONCLUSION**

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess fees to the same deposit account.

Respectfully submitted,

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